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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,892	12/14/2000	Takayuki Yamamoto	Q62230	5759

7590

10/23/2002

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

9

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/19/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, applicants' amended claim 1 is confusing since the claim appears to be unclear as to just what particular type of "molecular weight" is being referred to in line 3 of claim 1 after the recent claim amendment of a "weight average molecular weight" having a certain range set forth in lines 4-5 of the claim. Note also that applicants' specification appears at certain points to contain the same ambiguity, i.e., using the same two terms as if they are interchangeable, or as if only weight average molecular weight is intended, such as in "Reference Examples" 4,⁵ and 6. Additionally, it is further noted that claim 1 now contains the term "comprising" in three places in the first two lines of the claim and at times it appears that two of them may refer to the same ingredient, and as such are also believed to create confusion and apparent ambiguity in the claims. Clarification is requested.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP -470, substantially for the reasons set forth in

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paragraph No. 7 of Paper No. 5, together with the following additional observations. Although applicants argue in their response (page 5, last complete paragraph) that the newly added presence of the weight average molecular weight range eliminates the anticipation rejection of record, the Examiner must respectfully disagree. The newly claimed weight average molecular weight range of 930,000 to 2,100,000 is believed to at the very least intersect with the preferred number average MW range of 100,000 to 500,000 taught (page 7, line 6) by the reference. In support of the Examiner's position note as evidence of the state of the art, chapter IV, pages 49-53 of "Organic Coatings: Science and Technology", Volume 1, 1992, particularly at page 51, the last complete paragraph. In particular, note the teaching wherein the 2/1 minimum theoretical relationship taught as existing between the two MW ranges leads to the clear conclusion that at least the upper range taught by the reference clearly overlaps with at least the lower part of applicants' newly claimed range.

With respect to applicants' contention that the presence or absence of the low "molecular weight" (what range is intended?) component is a result effective factor, the Examiner again believes that the less than 10% parameter is both either an inherent property of at least some of the disclosed compositions as well as, alternatively, an obvious modification to one of

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ordinary skill for reasons previously set forth in paragraph No. 7 of Paper No. 5, as well as for the advantages attained by resource saving and improved environmental health, applicants' comments to the contrary (Response, page 6, top paragraph) notwithstanding.

4. Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -470, substantially for the reasons set forth both above and in paragraph No. 7 of Paper No. 5, together with the following additional observations. Applicants have argued only that their claim is dependent upon claim 1 and thus accordingly must fall, but the Examiner believes that this argument is not valid for the reasons set forth above. Finally, as was previously stated, the polymerization of acrylic based pressure sensitive adhesives in the presence of liquid or supercritical carbon dioxide is a product-by-process limitation not as yet shown on the record to produce a patentably distinct article.

5. Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -470, taken in view of applicants' admissions in the specification regarding the usage of pressure sensitive adhesive sheets in semiconductor processing operations on page 1 and extending to page 2, line 7 of the specification. Applicants recite only the method steps of "adhering" the adhesive sheet and "processing" the wafer, which are both

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strongly believed to be conventional method steps, as is apparently admitted in the specification. Additionally, although the prior art referred to in the specification relates to the semiconductor processing art, this admission is believed to be combinable with prior art disclosing a "removable pressure sensitive adhesive sheet" such as EP -470 in an expectation of improved performance properties by usage of the adhesive sheets taught therein.

6. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 18, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker